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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/656,446	09/05/2003	Steven K. Coulthard	16217-002001	8480
26181	7590	02/13/2006	EXAMINER	
FISH & RICHARDSON P.C. PO BOX 1022 MINNEAPOLIS, MN 55440-1022			MAYES, DIONNE WALLS	
			ART UNIT	PAPER NUMBER
			1731	
DATE MAILED: 02/13/2006				

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

10/656,446

Applicant(s)

COULTHARD, STEVEN K.

Examiner

Dionne Walls Mayes

Art Unit

1731

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 09 December 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-17 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-17 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

Art Unit: 1731

### **DETAILED ACTION**

1. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

2. Claims 1-17 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Applicant has amended the claims to include "a continuous wall extending between the open end and the closed end forming the hollow interior", and the open end is "permanently open"; however, neither of these changes appear to be adequately supported by the instant written disclosure, and the Examiner does not believe that the drawings give sufficient support for these amendments.

### ***Claim Rejections - 35 USC § 103***

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1-6, 8-15 and 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hicks (U.S. Patent No. 6,463,936) in view of Walker (U.S. Patent No. 6,142,769). Regarding claim 1, Hicks teaches an apparatus for extinguishing and

Art Unit: 1731

containing a cigarette, the apparatus comprising a container having an open end (said end obviously able to be structured as "permanently opened", since one having ordinary skill in the art would have been motivated to adapt an "open end" embodiment that is free from a closure mechanism - i.e. cap or lid - similar to that disclosed in Fig. 4, to enable unblocked and immediate cigarette access); a hollow interior having a substantially constant interior diameter; a closed end, wherein the open end is configured to receive a cigarette, the interior is configured to contain a cigarette and the container is configured to extinguish a cigarette; a clip including: a first portion grasping an exterior of the container; and a first and a second resilient arm, each arm extending from the first portion configured to grasp a cigarette lighter, the first arm bowed toward the second arm and the second arm bowed toward the first arm (Figure 5). Hicks fails to teach a bottle opener connected to the exterior of the container. However, Walker teaches that it is known to combine cigarette lighters with other devices, i.e., bottle openers; therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to combine the teaching of Hicks with the teaching of Walker in order for the user of the apparatus to accomplish a plurality of tasks with a single tool (Walker, column 1, lines 5-6). Accordingly, claim 1 is rejected.

Regarding claims 2 and 12, Walker teaches the container is a cylindrical container (Figure 1). Accordingly, claim 2 is rejected.

Regarding claims 3 and 13, Walker teaches a can tab opener connected to the exterior of the container (Figure 1, tip of reference number 42). Accordingly, claim 3 is rejected.

Regarding claims 4 and 14, Hicks teaches that the interior diameter of the container is such that a lit cigarette will lodge in the interior of the cylindrical container and self-extinguish (Figure 1; column 2, lines 7-10). Accordingly, claim 4 is rejected.

Regarding claim 5, Hicks fails to teach that the interior of the closed end of the container is a convex surface extending toward the open end. However, due to a lack of criticality and unexpected results, designing the container such that the interior of the closed end of the container is a convex surface extending toward the open end is a matter of design choice. Accordingly, claim 5 is rejected.

Regarding claims 6 and 15, Hicks teaches the container comprises a heat-resistant plastic (column 3, lines 30-31). Accordingly, claims 6 and 15 are rejected.

Regarding claim 8, Hicks fails to teach the container is connected to the clip by a snug-fit connection. However, due to a lack of criticality and unexpected results, it would have been obvious to one of ordinary skill in the art to connect the clip to the container by a number of different ways, include using a snug-fit connection. Accordingly, claim 8 is rejected.

Regarding claim 9, Hicks teaches the first portion of the clip includes two or more grooves (point where area bowed region 66 meets area indicated by 64 on each side of container) on an exterior of the first portion (indicated by reference portion 64 in Figure 5) adapted to receive the fingers of a user of the apparatus. Accordingly, claim 9 is rejected.

Regarding claims 10 and 17, Walker teaches the apparatus may comprise a pen tip connected to the container (Figure 1, reference number 34) and a light connected to

Art Unit: 1731

the container (Figure 2, reference number 44). Accordingly, claims 10 and 17 are rejected.

Regarding claim 11, Hicks teaches an apparatus for extinguishing and containing a cigarette, the apparatus comprising a container having: an open end, a hollow interior having a substantially constant interior diameter, and a closed end, wherein the open end is configured to receive a cigarette, the interior is configured to contain a cigarette and the container is configured to extinguish a cigarette; a first and a second resilient arm, each arm extending from the first portion configured to grasp a cigarette lighter, the first arm bowed toward the second arm and the second arm bowed toward the first arm (Figure 5). Hicks fails to teach a bottle opener connected to the exterior of the container. However, Walker teaches that it is known to combine cigarette lighters with other devices, i.e., bottle openers; therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to combine the teaching of Hicks with the teaching of Walker in order for the user of the apparatus to accomplish a plurality of tasks with a single tool (Walker, column 1, lines 5-6). Accordingly, claim 11 is rejected.

5. Claims 7 and 16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hicks as applied to claim 1 above, and further in view of Hawley's Condensed Chemical Dictionary (pgs. 3 and 1097). Hicks teaches that the container is made from a heat-resistant plastic (column 3, lines 30-31). Hicks fails to teach that the clip is made from a heat-resistant plastic. Hicks also fails to teach that the container and the clip comprise a glass filled ABS plastic. Hawley's Condensed Chemical Dictionary teaches that ABS resins or plastics are any of a group of tough, rigid thermoplastics (pg. 3).

Thermoplastics are high polymers that soften when exposed to heat and return to their original condition when cooled to room temperature (pg. 1097). They are heat-resistant. It would have been obvious to one of ordinary skill in the art at the time of the invention to combine the teaching of Hicks with the teaching of Hawley's Condensed Chemical Dictionary making the container and the clip of the apparatus from an ABS plastic, specifically a glass filled ABS plastic, because such plastics are heat resistant and could withstand being exposed lit cigarettes. Accordingly, claims 7 and 16 are rejected.

***Response to Arguments***

6. Applicant's arguments filed 12/9/2005 have been fully considered but they are not persuasive.

- Applicant argues that Hicks teaches against a container that is "permanently open", but the Examiner disagrees, and feels that one having ordinary skill in the art would have been motivated to modify the "open end" structure of the container, of Fig. 1, to be unblocked or "permanently open", which is even suggested by the Fig. 4 embodiment, in order to allow for quick and easy access of the cigarette into the container. It is not deemed that the "permanently open" amendment results in a limitation that is patentably distinguishable from the Hicks disclosure.

- Applicant argues that Hicks teaches away from a container having a hollow interior with a substantially constant diameter since there is a slight taper to the container; however, since Applicant has recited that the interior has a "substantially" constant diameter, and since "substantially" is a relative term, it is believed that the container of Hicks has a diameter that is "substantially" constant – which would allow for

a slight taper in the overall diameter, since the term "substantially" can mean different things to different observers.

- Applicant argues that the "clip" which is recited in the claims is not taught by Hicks because it fails to disclose two resilient arms, as claimed. However, the Examiner believes that Hicks does disclose the claimed two arms 64 (i.e. U-shaped resilient component), said two arms just happen to be joined by extent 66.

- Applicant argues that there is no motivation to combine Hicks with Walker to arrive at the claimed "bottle opener connected to the exterior of the container"; however, the Examiner disagrees, and believes that the Walker reference is exemplary of numerous patents that teach the benefits of having a bottle opener attached to a cigarette lighter. And, obviously, any bottle opener that is also attached to a cigarette lighter (as disclosed in Walker) would also, in the combination of Hicks and Walker, be "connected to the exterior of the container", as claimed. If Applicant intends to further distinguish this feature from the applied references, then recitation such as: ".....a bottle opener integral with the exterior of the container" should be considered.

### ***Conclusion***

7. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the



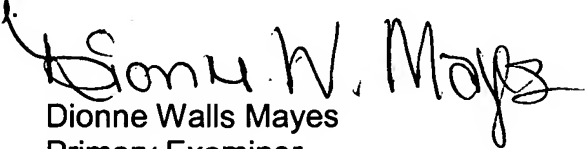
Art Unit: 1731

shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dionne Walls Mayes whose telephone number is (571) 272-1195. The examiner can normally be reached on Mon-Fri, 7AM - 4:30PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Steven P. Griffin can be reached on (571) 272-1189. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
Dionne Walls Mayes  
Primary Examiner  
Art Unit 1731

February 8, 2006